

Patent  
Attorney Docket: AUS920010175US1  
(IBM/0004)

### REMARKS

Claims 1-6, 8-20 and 22-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,561,422 issued to Cariffe, in view of U.S. Patent No. 5,122,953 issued to Uekusa, *et al.* Cariffe provides a system and method for converting markings made on a media with a marking agent into a digital form representing the markings. (Cariffe, Abstract). Cariffe teaches that an advantage to the disclosed method and system provides detection of markings that occur over the original document and that might obscure the original markings when the marked up media is scanned into a computer. (Cariffe, col. 3, lines 39-48). Cariffe further discloses that after an original document is marked up, it may be scanned and the markings may be separately printed in a new document or the markings may be printed as incorporated with the old document. (Cariffe, col. 5, lines 7-31).

Uekusa discloses a word processor capable of creating a formula during a document editing process by automatically setting a range of a formula in a document being edited with an instrument of a formula process start command and allowing a switching operation between the document editing process and the formula creating process to be easily made. (Uekusa, Abstract). Uekusa solves the problem that occurred when creating a document that includes a formula on a word processor, the input of the formula portions were processed separately from that of the ordinary text by defining a floating block or a fixed block, and that these blocks cause the problem in that not only is an additional step required for the operation of defining a block for the input of the formula, but also the operation of re-defining the block size when the size of the formula must be increased during the editing process. (Uekusa, col. 1, lines 14-35). Uekusa discloses a system comprising computer components, a CRT display and a keyboard and pointing device that can, like all word processors, display character spacing, character arrangement, and their printing formats on the CRT and can perform versatile document editing on an arbitrary area or a reserved area in the arbitrary area by using the keyboard and the pointing device. (Uekusa, col. 4, lines 17-29). Uekusa further discloses that the *keyboard and pointing device provides the functions* of editing character and symbol inputs, editing graphic inputs such as lines, rectangles, circles, ellipses or the like, editing graphics using the scanner and the pointing device and printing created document data or the like. *Id.*

Applicant claims methods, a system and a computer program product that comprise, *inter alia*, identifying images in an online version of an offline document, wherein the images include one

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or more editing instructions and generation of a subsequent version of the online document by executing each of the one or more editing instructions. (Claims 1, 9, 14, 15, and 23).

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Examiner determined that Cariffe teaches or suggests Applicant's claimed limitation of *identifying and executing* the one or more editing instructions at the identified location." (Office Action, p. 3, ¶ 2, emphasis added). Applicant respectfully asserts that the markings made upon the document by the radiation emitting ink of Cariffe are not editing *instructions* to be *executed* by the Cariffe system. Instead, the instructions that are executed by Cariffe are part of a computer program that merely instructs the computer to identify the markings by their special ink and then to convert the marking to a computer readable or digital form to produce a document that is then a *fully editable text*. (Cariffe, column 5, lines 15-17). Cariffe does not suggest or teach a system that edits a document by *executing editing instructions* identified from *markings* on an online version of an offline document, only one that turns a marked up copy of a document into a document that is *then fully editable*. There are no instructions provided by the markings made in special ink, other than at best, to scan and convert the markings to a digital format. However, the instruction to scan and convert the markings to a digital format are *not* instructions provided to the computer to execute *by the markings*, but are merely instructions from a computer program to scan for the special ink and convert the images found to a digital format. The instructions executed by the Cariffe system do not include *identifying and executing* editing instructions because Cariffe recognizes that the document is merely being prepared for editing, not being edited.

Therefore, because Cariffe does not teach or suggest identifying and executing editing instructions from images in an online version of an offline document, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. Reconsideration and withdrawal of the rejection of independent claims 1, 9, 14, 15, and 23 is respectfully requested as well as all dependent claims depending therefrom.

The Examiner determined that Cariffe did not teach Applicant's claimed limitation that the

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editing instructions are selected from a predetermined set of editing symbols as claimed by Applicant in independent claims 9 and 14 and dependent claims 8, 22 and 30. (Office Action, p. 4, ¶ 1). While the Examiner cited Uekusa for teaching this limitation, Applicant has been unable to find this teaching in Uekusa. As cited above in the relevant portion cited by the Examiner, Uekusa merely teaches that a keyboard and a mouse (pointing device) can be used to edit a document displayed on a CRT screen. This is not what Applicant claims and such use of a keyboard and mouse does not teach or suggest that the editing instructions identified from markings made on an offline version of an online document may be selected from a predetermined set of editing symbols as claimed by Applicant.

During the telephone interview, the Examiner pointed out that FIG. 12 of Uekusa includes a set of editing instructions. Applicant respectfully asserts that FIG. 12 provides a list of shortcut keys that, when one or more keys are typed by the user and identified as a shortcut key, then the word processor displays a pre-selected symbol or series of symbols. For example, when using the word processor application Microsoft Word, pressing the alt key, the ctrl key and the "r" key simultaneously provides the registered trademark symbol, ®. Applicant respectfully asserts that such shortcut keys are not editing instructions any more than typing the letter "r" is an editing instruction.

Therefore, because Uekusa does not teach or suggest Applicant's claimed limitation, found in claims 8, 9, 15, 22 and 30, that the editing instructions are selected from a predetermined set of editing symbols, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. Reconsideration and withdrawal of the rejection of independent claims 9 and 15 is therefore respectfully requested as well as those dependent claims that depend therefrom. Furthermore, reconsideration and withdrawal of the rejection of dependent claims 8, 22 and 30 is therefore respectfully requested.

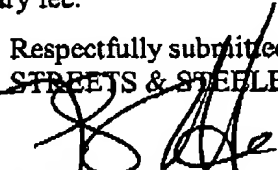
Claims 7 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,561,422 issued to Cariffe, in view of U.S. Patent No. 5,122,953 issued to Uekusa, *et al.*, and further in view of U.S. Patent No. 6,070,175 issued to Meizei. For the reasons provided in the remarks above concerning independent claims 1 and 15, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 7 and 21 that depend, either directly or indirectly, from independent claims 1 and 15.

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In closing, Applicant respectfully asserts that the combination of the cited prior art references do not teach or suggest that editing instructions may be *identified* on an offline document and *executed* on an on-line document as claimed by Applicant. Cariffe discloses that a document may be scanned and that certain images may be identified because they were written with a special, different ink. Cariffe does not teach or suggest that any of the images written in the special, different ink are identifiable as executable instructions. Uekusa discloses that a word processor may format and create documents as instructed by a user using a keyboard and a pointing device. Uekusa does not teach or suggest that any instruction may be entered into the word processor by any means other than the well known and typical means - by using the keyboard and mouse. Neither of the prior art references teach or suggest that executable instructions may be entered into the computer by having the computer *identify* images from an offline document that include one or more editing instructions and then *executing* the editing instructions. Applicant respectfully asserts that the two prior art references fail to suggest or teach that *executable instructions* may be *identified* in an off line document and then *executed* to produce a fully edited on line version of the document.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests the timely issuance of a Notice of Allowance. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0004 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,  
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